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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* HANNES EBERLE, CHRISTOPHER S. LEON,  
BODO MAASS, ANURAG PATNAIK,  
ALBERTO SANTA ANA,  
and MICHAEL ZIRNGIBL

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Appeal 2008-1375  
Application 09/661,375  
Technology Center 2600

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Decided: July 24, 2008

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Before JOSEPH F. RUGGIERO, MAHSHID D. SAADAT,  
and KEVIN F. TURNER, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 27-36 and 38-45, which are all of the claims pending in this

application. An oral hearing on this appeal was conducted on June 19, 2008. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

Appellants' invention relates to a system and a method for creation and automatic deployment of voice services that allow for on the fly content and speech generation. (Spec. 1:2-6).

Claim 27 is illustrative of the invention and reads as follows:

27. A method for generating an interactive voice broadcast, comprising:

providing at least one voice service, to which a plurality of users may subscribe, that can output personalized content during an interactive voice broadcast;

generating content for the at least one voice service when the at least one voice service is executed;

generating a unique active voice page for each subscriber of the at least one voice service, wherein a unique active voice page comprises personalized content created by applying subscriber-specific personalization information for a subscriber to the generated content, and further comprises one or more input elements embedded in the unique active voice page used to request input from the subscriber;

initiating an outbound communication to a subscriber to establish an interactive voice broadcast with the subscriber; and

dynamically interacting with the subscriber in real-time during the subscriber's interactive voice broadcast by presenting the personalized content to the subscriber from the subscriber's unique active voice page, and by enabling the subscriber to respond to the personalized content via the one or more input elements embedded in the subscriber's unique active voice page.

The Examiner relies on the following prior art references to show unpatentability:

Lumelsky	US 6,246,672 B1	Jun. 12, 2001
Honarvar	US 6,430,545 B1	Aug. 6, 2002
Ladd	US 6,539,359 B1	Mar. 25, 2003

Claims 27, 28, 34, 35, 43, and 44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lumelsky and Ladd.

Claims 29-33, 36, 38-42, and 45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lumelsky, Ladd, and Honarvar.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs and Answer for the respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived [see 37 C.F.R. § 41.37(c)(1)(vii)].

## ISSUES

(i) Under 35 U.S.C. § 103(a), with respect to appealed claims 27, 28, 34, 35, 43, and 44, do Lumelsky and Ladd teach or suggest all of the elements of those claims to render those claims unpatentable?

(ii) Under 35 U.S.C. § 103(a), with respect to appealed claims 29-33, 36, 38-42, and 45, do Lumelsky, Ladd, and Honarvar teach or suggest all of the elements of those claims to render those claims unpatentable?

## PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore,

“...there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

## ANALYSIS

Appellants argue that delivering content in response to a user request, such as provided in Lumelsky, is distinct from initiating an outbound communication to a subscriber to establish an interactive voice broadcast with the subscriber. (App. Br. 17; Reply Br. 11-12). Appellants allege that Lumelsky “consistently indicates that content is delivered to users ‘upon their request’ [Lumelsky, Abstract].” (App. Br. 18). As discussed below, we have not been able to find such an equivalent element in either Lumelsky or Ladd.

Claim 27 recites, in part, “initiating an outbound communication to a subscriber to establish an interactive voice broadcast with the subscriber.” Similarly, claim 28 recites, in part, “means for initiating an outbound communication to a subscriber to establish an interactive voice broadcast with the subscriber.” During the Oral Hearing, Appellants’ Representative indicated that the structure that supports that means-plus-function element is the software components 181 that include a call builder 1813. (Oral Hearing Transcript pp. 8-9). Further to Appellants’ arguments, we find no elements in either Lumelsky or Ladd that teach or suggest such a process step or the disclosed structure. While the Examiner has presented several reasons to rebut these arguments, we do not find them to be compelling.

The Examiner finds that since Lumelsky discloses “push technology,” this implies that one of ordinary skill in the art could have modified that system to have outbound communication be initiated at the publisher or server. (Ans. 14). However, we agree with Appellants since the independent claims do not merely recite the initiation of the communication, but also that that communication establishes an interactive voice broadcast with the subscriber. Since Lumelsky clearly teaches the establishment of an interactive session by the user, such as discussed, for example, in Lumelsky’s abstract, there would need to be motivation to change the clear disclosure of Lumelsky. The fact that Lumelsky may discuss “push technology” is not sufficient motivation to change the way Lumelsky’s disclosed invention operates.

Additionally, the Examiner alleges that just because Lumelsky discloses that the user calls up the radio service and logs on, that does not “preclude the fact that the communication is initiated by the network

server.” (Ans. 14-15). However, even if the Examiner is correct, an obviousness rejection must rely on what a reference teaches or suggests, not what a reference fails to preclude. The Examiner also asserts that “the fact that a user must call up and log on to establish service does not impact one way or the other who initiates a communication of the information.” (Ans. 15). We find, however, that such consideration misses the point, as the specific initiation of outbound communication is used to establish the session, as recited in independent claims 27 and 28, and must be taught or suggested by the references cited in the rejection.

Lastly, the Examiner suggests that claim differentiation and providing the broadest reasonable interpretation allows for independent claims 27 and 28 to be understood from the perspective of a user establishing the session and subsequent delivery of information to the user. (Ans. 15). We agree with Appellants in that at most the claim differentiation provides that the methods of communication in the independent claims 27 and 28 need to encompass more than “initiating an outbound telephone call,” as required by the dependent claims. Additionally, while the Examiner is correct that Appellant’s Specification discloses many different embodiments, we find that recitations of the claims make clear which embodiments the instant claims read upon.

In addition, we find that Ladd also fails to teach or suggest the disputed elements of claims 27 and 28. As such, we find clear error in the rejection of claims 27 and 28 over Lumelsky and Ladd, as the cited references fail to teach or suggest all of the elements of those claims. While Appellants make additional arguments with respect to elements of independent claims 27 and 28 that are not taught or suggested by Lumelsky

and Ladd, we need not reach these arguments based on the defects in the rejection that we have discussed above. By virtue of their dependence on claims 27 and 28, we find the rejection of claims 34, 35, 43, and 44 to likewise have been made in error.

With respect to the rejection of claims 29-33, 36, 38-42, and 45, over Lumelsky, Ladd, and Honarvar, we note that those claims all depend from independent claims 27 and 28. Honarvar fails to teach or suggest the disputed element of claims 27 and 28 discussed above, and thus Lumelsky, Ladd, and Honarvar cannot teach or suggest all of the elements of claims 29-33, 36, 38-42, and 45 by virtue of their dependence on the independent claims. As such, we find that the rejection of claims 29-33, 36, 38-42, and 45 is improper and cannot be sustained.

#### CONCLUSION

In summary, we have reversed the Examiner's 35 U.S.C. § 103(a) rejections of all of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 27-36 and 38-45 is reversed.



Appeal 2008-1375  
Application 09/661,375

REVERSED

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